



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/754,441

01/04/2001

Shinji Yoshihara

39303.20219.00

3382

25224 7590 09/15/2008
MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

EXAMINER

RECEK, JASON D

ART UNIT

PAPER NUMBER

2142

MAIL DATE

DELIVERY MODE

09/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/754,441 | Applicant(s) YOSHIHARA ET AL. | |
| | Examiner JASON RECEK | Art Unit 2142 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to the RCE filed on June 10th 2008 which concerns application 09/754441.

Status of Claims

Claims 35-43 are pending.

Claims 35-37 and 39-43 are currently rejected under 35 U.S.C. 101.

Claims 35-43 are currently rejected under 35 U.S.C. 103(a).

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/10/08 has been entered.

Response to Arguments

2. Applicant's arguments, with respect to the rejection(s) of claim(s) 34-41 under 103(a) have been fully considered and are persuasive. Specifically, Moller and Timis do

not disclose a parentage relationship as now recited by the independent claims.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bly et al. US 5,008,853.

Drawings

3. The drawings are objected to because Fig. 1 contains a misspelling in item 1d "storege" should be storage, Fig. 8 misspells the word transmit as "taransmit" in item SC1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “setting section” as recited by claim 35, the “second music data transmitting section” as recited by claim 36, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 35-37 and 39-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 35, it is directed to a server apparatus however the claim does not recite any physical hardware elements that would preclude the claim from being rendered entirely in software. Software is considered functional descriptive material and is not per se patentable. See MPEP 2106.01.

Claims 36-37 and 42 do not recite any features (i.e. hardware or computer readable medium) that would render the subject matter patentable. Therefore they are also rejected since they depend from a rejected claim.

Claims 39-41 and 43 correspond to 35-37 and 42, they are rejected for similar reasons.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2142

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 35-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moller et al. U.S. Pat. 6,598,074 B1 in view of Timis et al. U.S. Pat. 5,792,971 and in further view of Bly et al. US 5,008,853.

As to claim 35, Moller teaches substantially the invention as claimed, including a server apparatus (*Fig. 1, server 12*) communicably connected to a plurality of client apparatuses (*Fig. 1, clients 14, 16*) through a communication network (*Fig. 1, Internet 18*), for performing a music composing work (*a multimedia project*) according to information input at the plurality of the client apparatuses to thereby create a file of music data (*a multiple "takes" record, data units, tracks*) under collaboration (*Abstract*) of a plurality of users of the plurality of client apparatuses with collecting ideas (*collaborators' contributions, col. 4, lines 35-40*) of the plurality of the users, the server apparatus comprising:

a data storage section that stores music data ... under the music composing work (*virtual studio, col. 4, lines 5-15*);

an information transmitting section that transmits display information directly to each of the client apparatuses such that each client apparatus displays a composing screen and a chat screen according to the directly transmitted display information (*col. 4, lines 15-33*);

a data receiving section that directly receives from each client apparatus composing data, which is generated by the client apparatus based on the information associated with the music composing work and input to the composing screen displayed according to the display information, and which represents either of a partial composing content or partial editing content of the music data (*col. 4, lines 26-49*);

a composing and editing section that performs the music composing work including input and edition of the music data according to the composing data directly received from each client apparatus to thereby update the music data stored in the data storage section (*col. 4, lines 26-49*);

and a music data transmitting section that responds to an updating request from the client apparatus for directly transmitting the updated music data stored in the data storage section as display information to the client apparatus such that the client apparatus can display the updated music data of a MIDI format on the composing screen (*col. 4, lines 26-49*).

Moller does not explicitly disclose “stores music data of a text format” however this is taught by Timis as storing music data (*col. 7 ln. 35*) in as a textual representation (*col. 7 ln. 54-55, Fig. 4d*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Moller by storing musical data in text form as taught by Timis for the purpose of reducing file size. Moller discloses that media files take up a lot of disk

space therefore it is necessary to remove unused files (col. 27 ln. 32-33), storing media files as textual representations is another way of solving this problem.

Moller also does not disclose "wherein the updated music data is converted from the text format to the MIDI format at either the server apparatus or the client apparatus" however this is taught by Timis as a processing unit with a MIDI output so that whatever form the music is stored in can be converted to MIDI format (col. 7 ln. 25-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the conversion feature taught by Timis into Moller for the purpose of playing back music. A text file may not be played and thus would have to be converted in order for the collaborator to hear the music. A MIDI file is well known in the art and yields predictable results.

Moller and Timis do not disclose "a setting section that sets parentage among the plurality of the client apparatuses such that one of the client apparatuses becomes a parent client apparatus and other client apparatus becomes a child client apparatus, the parent client apparatus having a right to enable the server apparatus to execute a specific process ... the child client apparatus having no right to enable the server apparatus to execute the specific process" however this is taught by Bly as access control (col. 8 ln. 50-56, col. 10 ln. 21-25, col. 12 ln. 54-64) that enables a user (parent) to perform operations while other users (child) cannot.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Moller and Timis with the teaches of Bly for the purpose of

controlling access. Bly suggest that by controlling access interference from other users is prevented (col. 8 ln. 50-53).

As to claim 36, Moller discloses including a second music data transmitting section that responds to a data save request from the client apparatus for converting the music data stored in the data storage section from a data format which is editable to another data format which is performable, and directly transmitting the music data the MIDI format to the client apparatus (*col. 4, lines 26-56*).

Moller does not explicitly disclose converting data “from the text format which is editable to the MIDI format” however this is taught by Timis as storing music in a editable text format and then processing to create a music signal which can be outputted to a MIDI device (col. 5 ln. 38-40, col. 6 ln. 60-61 and col. 7 ln. 54-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the conversion feature taught by Timis into Moller for the purpose of playing back music. A text file may not be played and thus would have to be converted in order for the collaborator to hear the music. A MIDI file is well known in the art and yields predictable results.

As to claim 37, Moller discloses a registering section that registers conversation data (*chat administration, col. 4, lines 57-64*);

a conversation data update section that directly receives from the client apparatus the conversation data which is generated according to the message input to the chat screen, and that updates the conversation data registered in the registering section each time the conversation data is received (*col. 4, lines 1-64*); and

a conversation data transmitting section that responds to a chat update request from the client apparatus for directly transmitting the updated conversation data registered in the registering section (*col. 4, lines 1-64*).

Claim 38 is a computer readable medium claim that corresponds to the server apparatus as claimed in claim 35; therefore, it is rejected under the same rationale as in claim 35.

Claim 39 corresponds to the server-side apparatus claim of claim 35 but on the client-side apparatus of the system; the functions on server and client are exchangeable; therefore, it is rejected under the same rationale as in claim 35.

Claim 40 corresponds to the server-side apparatus claim of claim 36 but on the client-side apparatus of the system; the functions on server and client are exchangeable; therefore, it is rejected under the same rationale as in claim 36.

Claim 41 corresponds to the server-side apparatus claim of claim 37 but on the client-side apparatus of the system; the functions on server and client are exchangeable; therefore, it is rejected under the same rationale as in claim 37.

Regarding claim 42, Moller and Timis do not disclose "the parent client apparatus has the right to enable the server apparatus to save the music data, and the child client apparatus has no right to enable the server apparatus to save the music data" however this is taught by Bly as a lock that enables a user (parent) to perform a save while not allowing others (child) to save (col. 23 ln. 63 - col. 24 ln. 19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Moller and Timis with the teaches of Bly for the purpose of controlling access. Bly suggest that by controlling access interference from other users is prevented (col. 8 ln. 50-53).

Regarding claim 43, it correspond to claim 42, thus it is rejected for the same reasons.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lo et al. US 6,212,534 B1 discloses a collaboration system that controls editing of a collaboration work by issuing a right to modify to users (abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Thurs 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Recek/
Examiner, Art Unit 2142
(571)-270-1975

/Andrew Caldwell/
Supervisory Patent Examiner, Art
Unit 2142

